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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,610	11/01/2001	David H. Parker	58013-013500/US	6204
33717	7590	10/03/2003	EXAMINER	
GREENBERG TRAURIG LLP 2450 COLORADO AVENUE, SUITE 400E SANTA MONICA, CA 90404			CARIASO, ALAN B	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	10/003,610	PARKER, DAVID H.
	Examiner Alan Cariaso	Art Unit 2875
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>27 June 2003</u> .		
2a) <input checked="" type="checkbox"/> This action is FINAL . 2b) <input type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>8-10 and 12-30</u> is/are pending in the application.		
4a) Of the above claim(s) _____ is/are withdrawn from consideration.		
5) <input checked="" type="checkbox"/> Claim(s) <u>24-26</u> is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>8-10, 12-23 and 27-30</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.		
Application Papers		
9) <input checked="" type="checkbox"/> The specification is objected to by the Examiner.		
10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>11 February 2002</u> is/are: a) <input type="checkbox"/> accepted or b) <input checked="" type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input checked="" type="checkbox"/> The proposed drawing correction filed on <u>27 June 2003</u> is: a) <input checked="" type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input checked="" type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____		

DETAILED ACTION

Response to Amendment

Drawings

1. The proposed and formal drawings (of figures 24-29) were received on 27 June 2003. These drawings are approved by the examiner.
2. However, the drawings (regarding at least figure 3) are objected to because reference numeral "17" is incorrectly directed to the large frontal aperture in figure 3, which receives the lens 12, lens shroud 13, bulb 14 and reflector 15. This is incorrect because the written specification on page 4, lines 22-23 and page 7, lines 10-11 describes the aperture 17 otherwise: "there is also shown a boot actuator 16 which fits in the aperture 17 in the rear face of the battery casing 10" and "An actuator 16 fits around the stem 324 which protrudes from the aperture 17 and is covered by the boot actuator 16", respectively, which does not match the illustration in at least figure 3. Figures 1, 4 and 19 show the boot actuator visible from the rear face of the battery casing protruding from the intended aperture (not labeled as filed, but appears should be designated the aperture 17 as described). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are further objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "255" (Page 6, lines 31-32 (as amended) or originally at page 7, line 1). A proposed drawing correction or corrected drawings are required in reply to the Office

action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:
5. Page 6, line 14 (as amended) reads "I 14a and 1 15a". Originally, these were correctly written as "114a and 115a".
6. Page 6, lines 31-32 (as amended) or originally at page 7, line 1, reads "contact feet 255". Since there is no reference numeral 255 in the drawings, it is incorrect and it appears that it should instead be replaced with -205--, in regards to the "contact feet of the contact strips 204".

Appropriate correction is required.

Claim Objections

7. Claim 27 is objected to because of the following informalities:
8. Claim 27, lines 8-9, the terms "the battery housing the battery housing" are redundantly recited.
9. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. Claims 8-23 and 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 8, lines 9 & 10, "the battery back" has no antecedent basis and is indefinite as being meant as a back of the battery housing or a battery pack.

13. Claim 8, at least line 9, "the battery pack" (all other occurrences) has no antecedent basis. This battery pack is not considered to be synonymous to the "battery pack closure" on line 5, unless either all recited "battery pack" are corrected to include "closure" or a definite structural relationship is claimed between the "battery pack closure" and the "battery pack".

14. Claim 9, line 2, "a battery pack" is indefinite as being the same as or different from the preceding "the battery pack" in claim 8.

15. Claims 10-21 are indefinite for depending on indefinite claim 8.

16. Claim 22, last line 6, the limitation "a battery housing" is indefinite as being the same as or different from the preceding "a battery housing".

17. Claim 23, line 2, the limitation "the electrical contact means" is indefinite as being the same as or different from the "first contacts" recited in preceding claim 22.

18. Claim 27, line 10, "the battery pack" has no antecedent basis. This battery pack is not considered to be synonymous to the "battery pack closure" on line 6, unless either the "battery pack" is corrected to include "closure" or a definite structural relationship is claimed between the "battery pack closure" and the "battery pack".

19. Claims 28 and 29 are indefinite for depending on indefinite claim 27.

20. Claim 30, line 12, "the battery pack" has no antecedent basis.

21. Claim 30, lines 19 and 20, "the device" (both occurrences) is indefinite as referring to the preceding "recharger device" or a separate indistinctly termed device. It appears unlikely that the "recharger device" and the "device" are the same part since the device is recited to be located in the slot (of the recharger device) ... to permit release of the device (from the recharger device).

Claim Rejections - 35 USC § 102

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

23. Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by MARSHALL et al (US 4,382,220).

24. MARSHALL discloses a rechargeable battery pack (10, figs.1-3) including batteries (50,55) in relative side-by-side relationship (fig.2), an extension (23,40,45-fig.2) from the batteries (50,55-fig.2) for permitting the batteries to be connected in a battery housing (80) in a releasable manner (figs.3-5), first contacts (66) from the batteries (col.3, line 56 to col.4, line7) for permitting recharging of the batteries in a recharger, and the rechargeable battery pack (10) being locatable in the battery housing (80) by interlocking elements biased into engagement (78,79,85-88,99) and wherein the contacts (66) extend outwardly (fig.2) from a battery housing (20b) to permit contact

with a recharger; wherein the extension (23,40,45) for permitting the release includes the electrical contact means (40,45,94-fig.5) for connecting a flashlight bulb (90) of a flashlight electrically to the battery pack (10).

25. Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by CHONG (US 5,317,247).

26. CHONG discloses a rechargeable battery pack (10) including batteries (71,72) in relative side-by-side relationship (fig.3), an extension (13,36-fig.2) from the batteries (71,72-fig.3) for permitting the batteries to be connected in a battery housing (32) in a releasable manner, first contacts (18,21) from the batteries for permitting recharging of the batteries in a recharger, and the rechargeable battery pack (10) being locatable in the battery housing (32) by interlocking elements biased into engagement (102,104) and wherein the contacts (18,21) extend outwardly (via 64-fig.1) from a battery housing (32) to permit contact with a recharger; wherein the extension (13,36) for permitting the release includes the electrical contact means (26,28-fig.1).

27. As for any of the functional phrases "for permitting the release" and "for connecting a flashlight bulb of a flashlight electrically to the battery pack", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See

In re Casey, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Response to Arguments

28. Applicant's arguments with respect to claims 8-10, 12-21 and 24-26 have been fully considered and are persuasive. The rejections of these claims have been withdrawn.

29. Applicant's arguments with respect to the rejection(s) of claim(s) 22 and 23 under SHARRAH et al have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of MARSHALL et al (US 4,382,220) and CHONG et al (US 5,317,247).

Allowable Subject Matter

30. Claims 24-26 are allowed.

31. Claims 8-10, 12-21 and 27-30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. ROBERTSON, JR. et al (US 5,920,178) show a battery pack

(100 or 101-fig.1) that contains batteries (102) in side-by-side relation and includes an extension (top or front end 111) that includes contacts (111,115) that extend or at least allow external electrical-connective access through a slot (116) for recharging (116-fig.2) when the battery pack is positioned by in a housing (107-fig.1) by inter-engagement mechanism (103,105). FUJIWARA et al (US 5,459,389) show an integral battery pack (40-fig.3) of side-by-side batteries (41) with contacts (3,4,43,58) that extend from the battery terminals outward (fig.4B) through the housing slots (22,23) of a housing (10,11,21) in which the battery pack is contained, one of the contacts (3) connectable to a recharger (300-figs.5-6). SUZUKI et al (US 6,124,699) show a hand-held housing (4) containing a battery pack (2 or 3) which are both positioned in a recharging housing unit both integrally and separately (figs.1A-2C).

33. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (703) 308-1952. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Alan Cariaso
Primary Examiner
Art Unit 2875

AC
September 17, 2003